



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/883,230	06/19/2001	Stanley P. Santiago	06502.0337	9811

22852 7590 03/17/2005

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

EXAMINER

KHATRI, ANIL

ART UNIT

PAPER NUMBER

2124

DATE MAILED: 03/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/883,230

Applicant(s)

SANTIAGO, STANLEY P.

Examiner

Anil Khatri

Art Unit

2124

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

This action is in response to the request for re-consideration filed on 10/4/2004.

As per applicant's request claims 1-12 have been amended and new claims 13-20 have been entered.

As per applicant's request claims 1-20 have been considered but they are not persuasive.

Claims 1-20 stand rejected under 35 USC 102 (e) as being unpatentable over *Claussen et al* USPN 6,718,516.

Applicant argues,

I) "Accessing a custom tag library and the custom tag library includes one or more than tags designating an XPath operation" as to claims 1, 3 and 5.

II) "Determining a target data on which a determined action is to be performed by parsing an instructions to obtain XPath operation including target data" as to claim 6.

III) "Custom tag to facilitate accessing contents of a document object model by permitting use of XPath operation to access data" as to claims 7 and 8.

IV) "A tag handler that parses a custom tag includes in instructions and evaluates an XPath operation" as to claims 11 and 12.

V) Cited reference does not disclose "anything regarding XPath operation or XPath syntax".

In response to applicant's arguments,

I) It was noted that cited reference teaches accessing custom tag library and its operation as depicted in figure 4 and also discloses path operation to get to the particular node in the three either right or left node. Cited reference does not use the word "XPath" in particular but as

Art Unit: 2124

applicant has cited in his specification page 6 that XPath is XML path which provides syntax for specifying and selecting parts on an XML document. Therefore it is interpreted cited reference has taught and particularly cited on column 5, lines 45-67 “identifying tags name spaces and listing...” and column 6, lines 1-67. Thus, limitations are met by the references.

II) It was also noted by the reference that determining a target data on which a determined action is to be performed by parsing an instructions to obtain XPath operation including target data as represented in figure 3 column 5, lines 10-22, “if the outcome of the test... complete the preprocessing routine”. Therefore, examiner interprets that reference has disclosed parsing instructions and had obtained path (XPath) for XML. Therefore, limitations are met by the reference.

III) Cited reference also disclosed custom tag to facilitate accessing contents of a document object model by permitting use of XPath operation to access data. See figures 4-8 and summary of the invention also. Thus, limitations are met by the reference.

IV) It was also disclosed by the reference tag handler that parses a custom tag includes in instructions and evaluates an XPath operation. See figures 5-8 and column 7 lines 26-67. Therefore, limitations are met by the reference.

V) As it has been addressed above that reference does not explicitly cites XPath wording but teaches XML path which provides syntax for specifying and selecting parts on an XML document. As it is can be seen on column 19-20 and its functionality. Therefore, limitations are met by the reference.

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 13-20 rejected under 35 U.S.C. 102(e) as being anticipated by *Claussen et al* USPN 6,718,516.

Claussen et al teaches,

Regarding claims 13-20

Rejection of claim 1 is incorporated and further claims 13-20 cites limitations are cited in rejected claims therefore claims 13-20 are rejected.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 2124

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anil Khatri whose telephone number is 571-272-3725. The examiner can normally be reached on M-F 8:30-5:00 PM.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


ANIL KHATRI
PRIMARY EXAMINER